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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,985	02/02/2002	Bettina Kupfinger	Y0R920010745US1	5276
28342	7590	06/03/2005		EXAMINER
SAMUEL A. KASSATLY LAW OFFICE 20690 VIEW OAKS WAY SAN JOSE, CA 95120			HUYNH, THU V	
			ART UNIT	PAPER NUMBER
			2178	
DATE MAILED: 06/03/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/066,985	KUPPINGER ET AL.
	Examiner	Art Unit
	Thu V Huynh	2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 19 February 2005.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-20 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 02/19/2005 to application filed on 02/02/2002.
2. Claims 1, 3-6, 14-18, and 20 are amended.
3. Claims 1-20 are pending in the case. Claims 1, 14, and 20 are independent claims.
4. The rejections in the previous office action have been withdrawn in view of the amendment.

### *Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. **Claims 1-7, 10-12, 14-18, 20 are rejected under 35 U.S.C. 102(a) as being anticipated by ScanWise 2.00 Print out (hereinafter Printout), copyright 2001, pages 1-20.**

**Regarding independent claim 1, Printout teaches the steps of:**

- receiving a request to image a document through an electronic cover (Printout, pages 1-9; requests to scan an image through an electronic cover on the right hand side of scanwise application by clicking on “scan” button. The user is able to enter “Destination”, “Image Control”, “Dimensions”, “Advanced” information for scanning the image);

- processing the cover for the document, by validating data elements related to the document (Printout, pages 1-12; processing the cover by validating data elements entered by the user. For example, validating the user selection of file, clipboard, or fax, etc. as destination of the scanning to output the scanning image into a file of an application, a clipboard or fax);
- based on the validated data elements in the cover, automatically collecting data and populating at least some data fields in the cover by linking at least some data fields to independent software applications (Printout, pages 1-14; automatically collecting data and linking the data to destination applications, such as Photoshop, Microsoft Photo; fax, printer, clipboard, etc.);
- storing at least some of the data populated in the cover for automatic reuse by integrated applications, for preventing re-entry of the at least some of the populated data in the integrated applications (Printout; pages 1-18; storing the data for automatic reuse by intergraded Photoshop, Microsoft office document imaging, etc. applications. The use enters the data once in Scanwise application, rendering the data available for reuse and avoid re-entry in other applications, such as Photoshop, Microsoft office, etc. The entered data, such as orientation of the image is available for reuse, by pasting from the clipboard or scanning to applications, avoiding to re-entry of populated data in the integrated application).

**Regarding dependent claim 2**, which is dependent on claim 1. Printout teaches automatically indexing the populated data in an imaging application (Printout, pages 19-20; automatically indexing the populated data in the applications in order to displaying the image).

**Regarding dependent claim 3**, which is dependent on claim 2, Printout teaches the using the cover to review a submission (Printout, pages 2-7; user uses the cover to review before scanning the image).

**Regarding dependent claim 4**, which is dependent on claim 2. Printout teaches using the cover to update a request status (Printout; pages 2-7; updating a scanning request by clicking on scan button).

**Regarding dependent claim 5**, which is dependent on claim 2. Printout teaches using the cover to initiate a workflow for subsequent processing (Printout, pages 2-9; using the cover to initial a workflow for scanning the image into a particular file).

**Regarding dependent claim 6**, which is dependent on claim 3, Printout teaches feeding collected data to one or more intergated software applications (Printout; pages 7-14, 19-20; feeding collected data to Photoshop, Microsoft Photo; fax, printer, clipboard, etc.).

**Regarding dependent claim 7**, which is dependent on claim 1, Printout teaches processing the electronic cover includes setting an electronic checklist to validate critical data

elements related to the document (Printout, pages 2-7; electronic cover includes setting checklist).

**Regarding dependent claim 10**, which is dependent on claim 7. Printout teaches disclose the critical data elements include a mode of transmittal (Printout, page 3, transmitting to a file, fax, printer, etc.).

**Regarding dependent claim 11**, which is dependent on claim 7. Printout teaches the critical data elements include a new transaction (Printout, pages 2-7; new subject).

**Regarding dependent claim 12**, which is dependent on claim 7. Printout teaches the critical data elements include an update (Printout, pages 2-7; updating information).

**Claims 14-15, 17** are for a computer program performing the method of claims 1-2, 7, respectively and are rejected under the same rationale.

**Claim 16** is for a computer program performing the method of claim 3, 4 or 5, and is rejected under the same rationale.

**Claim 18** is for a computer program performing the method of claim 9, 11 or 12, and is rejected under the same rationale.

**Claim 18** is for a computer program performing the method of claim 10 and is rejected under the same rationale.

**Claim 20** is for a data management device performing the method of claim 1 and is rejected under the same rationale.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(b) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. **Claims 8-9, 13, 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Printout as applied to claims 1 and 7 above, and further in view of Anderson et al., US 2001/0054106 A1, provisional filed 23/2000.**

**Regarding dependent claims 8 and 13.** Printout does not explicitly teach the critical data elements include a customer number, or a customer master record.

Anderson teaches attaching extra information, such as invoice number, last payment date into a scanned image for reused by different applications (Anderson, [0020]).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Anderson's extra information into Printout to provide extra information which includes customer number, customer master record, invoice number or/and last payment date, etc. with the scanned image, since the combination would have allow different applications to use such information as Anderson disclosed.

**Claim 18** is for a computer program performing the method of claim 8 and is rejected under the same rationale.

**Regarding dependent claim 9**, which is dependent on claim 7, Printout does not teach the critical data elements include a contract number.

Anderson teaches attaching extra information, such as invoice number, last payment date into a scanned image for reuse by different applications (Anderson, [0020]).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Anderson into Printout to provide extra information with the scanned image, since the combination would have allowed different applications to use such information as Anderson disclosed.

#### *Response to Arguments*

9. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Applicants argue with respect to claims 1, 14, and 20 that, Cahill does not disclose "an important aspect of present invention is that the data is entered once in one application, and the present invention ensures that the data fields that have been entered are automatically available to, and inserted in integrated (or related) applications that require this data, without having to manually re-type the data".

Examiner agrees. However, Printout teaches these limitations as explained in the rejection above.

Applicants argue with respect to claims 1, 14 and 20 that, Paltenghe does not disclose “the user enters the data once in one application, rendering the data available for reuse in other applications”.

Examiner agrees. However, Printout teaches these limitations as explained in the rejection above.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Van Der et al., US 2003/0033319 A1, filed 08/2002, teaches entry for physical documents in a digital back-end system.

Johnson, US 5,850,490, filed 1995, teaches analyzing image of a document using alternative positioning of a class of segments.

Pineau et al., US 2003/0005050 A1, filed 07/2002, teaches method for providing output from remotely located digital files using remote printing.

Guheen et al., US 6,721,713 B1, filed 05/1999, teaches business alliance identification in a web architecture frame work.

Lent et al., US 2004/0039687 A1, priority filed 1998, teaches method for a verifiable on line rejection of an application for client.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu V Huynh whose telephone number is (571) 272-4126. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TVH

May 30, 2005



STEPHEN HONG  
SUPERVISORY PATENT EXAMINER